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APR 07 2006

PATENT APPLICATION

Do. No. 2705-111

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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**CENTRAL FAX CENTER**

APR 07 2006

In re application of: Michael E. Tasker

Confirmation No.: 5271

Serial No.: 09/583,695

Examiner: Shick C. Hom

Filed: May 31, 2000

Group Art Unit: 2666

For: PRIVATE BRANCH EXCHANGE (PBX) CONDITIONING  
METHOD AND APPARATUS

Date: April 7, 2006

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

This review is requested for the reason(s) stated on the attached sheet(s). Note: no more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor  
☐ assignee of record of the entire interest  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed  
☒ attorney or agent of record  
☐ attorney or agent acting under 37 CFR 1.34

Total of 4 forms are submitted.

Customer No. 20575

Respectfully submitted,  
MARGER JOHNSON & MCCOLLOM, P.C.*Julie L. Reed*Julie L. Reed  
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Portland, OR 97204  
(503) 222-3613I hereby certify that this correspondence  
is being transmitted to the U.S. Patent and  
Trademark Office via facsimile number  
(571) 273-8300 on April 7, 2006.*Janet Sullivan*  
Janet Sullivan

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PATENT APPLICATION  
Do. No. 2705-111

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Michael E. Tasker

Confirmation No.: 5271

Serial No.: 09/583,695

Examiner: Shick C. Horn

Filed: May 31, 2000

Group Art Unit: 2666

For: PRIVATE BRANCH EXCHANGE (PBX) CONDITIONING  
METHOD AND APPARATUS

Date: April 8, 2006

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE**

*The reference does not teach an apparatus capable of allowing a user to place calls outside a PBX system while connected to the PBX system.*

The independent claims are rejected under Holmquist, et al., US Patent No. 5,602,846. Previous rejections over other art were also made. However, none of the references teach an apparatus that allows a user connected to a PBX system to place a call 'other than via' the PBX.

Holmquist is directed to a simultaneous voice and data system (SVD). The Examiner has stated in the office action dated December 8, 2005, that Holmquist does teach the invention as claimed because, "the abstract recites voice calls being switched through the modem requiring no modification to the PBX and Fig. 1 which shows that call can be routed via the LAN using the SVD modem pool other than through the PBX 200..."

Upon inspection, the abstract state, "Both of these analog ports are capable of transmitting telephone numbers and are coupled to a switching system like a private branch exchange (PBX)...In response the SVD modem separately transmits, to the PBX, the calling party number from one of the analog ports and the called party number from the remaining analog port. The SVD modem then subsequently communicates any voice signals received

Application No. 09/583,695

1 of 3

Do. No. 2705-111

on one of the analog ports to the other analog port. This allows a voice call to be switched through the SVD modem, yet requires no modification to the PBX.”

This text indicates that once the call has been switched through the PBX, it can be maintained without modifying the PBX, but does not allow a call to be made ‘other than via’ a PBX, as claimed. This reference does not teach the apparatus of the invention.

Further, Figure 1 shows a connection between the SVD modem pool and a LAN, at least for user 1. User 2 shows no such connection to the LAN. Any connection between the users must go through the PBX. This is born out in the discussion of the figures further on in the patent. See for example, step 515 of Figure 3, and accompanying text at col. 4, lines 31-37; step 640 of Figure 4, and accompanying text at col. 6, lines 9-35; and Figure 5, step 735 and accompanying text at col. 7, line 66 through col. 8, line 19.

*In responding to previous arguments, the Examiner misunderstood the previous arguments or has read language into the claims that is not present.*

In response to the Applicants’ arguments in response to the office action dated June 11, 2005, the Examiner has stated in the most recent office action, dated December 8, 2005, that Holmquist teaches that the call is switched ‘without modification.’ Applicants have never made any arguments as to whether the call is modified to go through the PBX, nor is there any language in the claims with regard to modification. The invention as claimed is directed to the ability to place calls ‘other than via a PBX’ or ‘outside’ a PBX, when the phone is in a PBX system.

Further, the Examiner has also stated that switching equipment other than a PBX is taught by Holmquist at col. 9, line 60. This point has never been raised by the Applicants’ as the invention is directed to placing a call outside the switching equipment, the PBX, when connected to the switching equipment, not whether the switching equipment is a PBX or not. There is no language in the claims with regard to the PBX being some other sort of switching equipment.

*The Examiner has taken the position that the invention is obvious over currently available phone systems.*

Applicants’ representative had a phone interview with the Examiner on May 17, 2005. Applicants had submitted a draft amendment clarifying that the phone call placed ‘outside the PBX’ was more clearly a phone call place ‘other than via the PBX.’

During the interview, the Examiner stated that even with the limitation that the local call is made other than through the PBX is obvious. The arguments seemed to be based more on phone systems available today, such as that installed into the new USPTO site in

Alexandria, rather than what was available at the time this application was filed, approximately 5 years ago. Further, even this example given by the Examiner does not address the fact that the local call is made other than via the PBX while the user still connected to the PBX. If the user were not still connected to the PBX, there would be no reason to communicate the off-hook signal to the PBX.

The Applicant also asserts all arguments made previously, whether or not explicitly discussed herein, to preserve the right to assert these arguments in the Appeal Brief.

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Respectfully submitted,

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I hereby certify that this correspondence  
is being transmitted to the U.S. Patent and  
Trademark Office via facsimile number  
(571) 273-8300 on April 7, 2006.

Signature

*Janet Sullivan*  
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